

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

Mailed: September 2, 2014

Opposition No. 91216854 (parent)  
Cancellation No. 92059336

JST Performance, Inc. d/b/a/ Rigid  
Industries

v.

Halo2Cloud, LLC

**Cheryl S. Goodman, Interlocutory Attorney:**

Consolidation

The Board finds it appropriate to consolidate the Opposition and Cancellation proceedings as they involve common questions of law and fact and will provide the parties and the Board savings in time, effort and expense. *See* Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991).

Accordingly, Opposition No. 91216854 and Cancellation No. 92059336 are hereby consolidated and may be presented on the same record and briefs. *See Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

The Board file will be maintained in Opposition No. **91216854** as the “parent case.” From this point on, only a single copy of all motions and papers should be filed, and each such motion or paper should be filed in the parent case only, (except for the amended consolidated petition to cancel and answer thereto which should be filed in the cancellation proceeding). Any papers filed in the parent case should include in the caption all consolidated proceeding numbers, listing the “parent case” first.<sup>1</sup>

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

#### Discovery Conference

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties held a discovery and settlement conference August 27, 2014, after the discovery conference deadline in both proceedings.<sup>2</sup> See TBMP § 401.01. At applicant’s request, a member of the Board participated in the conference. Participating were Michael Wallace, counsel for

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<sup>1</sup> The parties should promptly inform the Board of any other Board proceedings or related cases within the meaning of Fed. R. Civ. P. 42, so that the Board can consider whether further consolidation is appropriate.

<sup>2</sup> The request for Board participation was sought by plaintiff less than ten days before the deadline for the discovery conferences in both proceedings but the Board accommodated the request.

opposer/petitioner and Tucker Griffith, counsel, for applicant/respondent, and the assigned Interlocutory Attorney identified above.

The Board apprised the parties of general procedural rules and guidelines that govern inter partes proceedings, including the Board's liberal granting of motions to suspend for settlement efforts, the requirement that a party serve its initial disclosures pursuant to Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii) prior to serving discovery requests<sup>3</sup> (see Trademark Rule 2.120(a)(3)), the requirement that a party serve initial disclosures prior to filing a motion for summary judgment, information relating to expert disclosures and pretrial disclosures<sup>4</sup>, and the availability of Accelerated Case Resolution (ACR) and the use of ACR efficiencies (e.g., stipulations of fact and evidence) in non-ACR cases.

#### Standard Protective Order

The Board's Standard Protective Order is automatically applicable to this proceeding pursuant to Trademark Rule 2.116(g). Although they are not required to do so, the parties may elect to exchange executed copies of the protective order. If the parties wish to modify the order in any manner, they must file a motion for the Board's approval of the modification(s). A copy of

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<sup>3</sup> For more information regarding formal discovery, the parties are directed to TBMP Chapter 400.

<sup>4</sup> Information regarding disclosures can be located in the Board Manual of Procedure (TBMP) at Chapters 401.02, 401.03 and Chapter 702. If the parties are interested in making more extensive disclosures, the parties are referred to the Miscellaneous Changes to TTAB Rules, January 17, 2006, located at <http://www.uspto.gov/trademarks/process/appeal/index.jsp> under "Rules/Laws."

the protective order is available on the Board's website  
<http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>.

### Service

The parties agreed to service by e-mail with courtesy copy by first class mail. The parties are not afforded any additional time for responding to motions (or discovery) with e-mail service.<sup>5</sup>

### Pleadings

The Board found the notice of opposition sufficiently pleaded. With respect to the answer to the notice of opposition, the Board struck affirmative defenses, 3, 4 and 7.<sup>6</sup> The Board found the petitions to cancel, which were filed as three separate petitions (and consolidated into one cancellation proceeding) insufficient as they only pleaded priority with no allegations of likelihood of confusion.<sup>7</sup> As set forth below, petitioner is afforded time to file a consolidated amended petition to cancel with respect to the registrations it seeks to cancel (rather than three separate petitions to cancel), and respondent will be afforded time to file an answer.

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<sup>5</sup> The parties should adjust their spam filters so that communications from the Board (uspto.gov) and the adverse party are received.

<sup>6</sup> The assertion of the right to put forward additional defenses is an improper reservation under the Federal Rules of Civil Procedure. *See FDIC v. Mahajan*, 923, F. Supp. 2d 1133, 1141 (N.D.Ill.2013). The way to plead additional affirmative defenses is to file a motion under Federal Rule of Civil Procedure 15. *Id.*

<sup>7</sup> Assertions of standing and priority without an allegation of likelihood of confusion are insufficient to state a claim of entitlement to relief. *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154, 156 (TTAB 1985).

Accelerated Case Resolution and ACR-like Stipulations

The Board briefly explained the availability of and features of the “accelerated case resolution” (“ACR”) process. For further information, the Board refers the parties to TBMP §§ 528.05(a)(2), 702.04 and 705, as well as the link on the Board’s web page to a vast amount of ACR information and exemplary ACR proceedings.

Stipulations

The parties should notify the Board of any stipulations with respect to evidence or testimony or with respect to modifying the discovery or trial schedule.

Telephone Conferences

Telephone conferences may be scheduled with the Board attorney to resolve disputed matters as appropriate.

Automated ESTTA Consent Motions

The parties are advised that ESTTA, the Board’s electronic filing system, is preferred for filing papers in the Board proceeding. As stated in the conference, the consent suspension and extension motion forms available on ESTTA should only be used after the deadline for initial disclosures has passed. In addition, the parties should carefully check that the dates generated in ESTTA are what they intend when using the automated forms.

Suspension for settlement

Proceedings are suspended for THIRTY DAYS from the date of the discovery conference for settlement discussions. Proceedings will resume on September 26, 2014, without any further action from the Board on the schedule set forth below.<sup>8</sup>

Amended petition to cancel (consolidated) due	10/6/14
Answer to amended petition to cancel due	10/26/14
Initial Disclosures Due	10/21/2014
Expert Disclosures Due	2/18/2015
Discovery Closes	3/20/2015
Plaintiff's Pretrial Disclosures	5/4/2015
Plaintiff's 30-day Trial Period Ends	6/18/2015
Defendant's Pretrial Disclosures	7/3/2015
Defendant's 30-day Trial Period Ends	8/17/2015
Plaintiff's Rebuttal Disclosures Due	9/1/2015
Plaintiff's 15-day Rebuttal Period Ends	10/1/2015

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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<sup>8</sup> The Board bases the revised disclosure, discovery and trial schedule on the schedule set forth in Opposition No. 91216854 as it has the later dates.